

**REMARKS**

Applicant respectfully requests favorable reconsideration of this application, as amended.

Applicant notes with appreciation the indication of allowable subject matter within Claims 1–3, 5–7, 9, 12 and 18. Claim 18 has been rewritten to be in independent form including all of the limitations recited by the base claim and any intervening claims, and Applicant submits that Claim 18 is allowable.

Claims 1–3, 5–7, 9–12 and 21 were rejected under 35 U.S.C. § 112, second paragraph. In particular, Claims 1 and 10 were rejected as lacking antecedent basis for “the sliding element,” while Claim 10 was rejected as being unclear with respect to the phrase “lies free.” In response, Claims 1 and 10 have been amended to provide proper antecedent basis for the sliding element, and Claim 10 has been amended to remove the wherein clause that recites the “lies free” feature. Applicant respectfully submits that the § 112, second paragraph, rejections have been overcome, and, furthermore, that Claims 1–3, 5–7, 9 and 12 are allowable.

Claims 10, 11 and 21 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because the Specification does not provide support for two limitations added to Claim 10 in the prior response, i.e., that the case is rigid relative to the base body, and that the resting surface lies free. Additionally, the Specification was objected to as failing to provide proper support for these features. In response, Claim 10 has been amended to remove these limitations, and Applicant respectfully submits that the § 112, first paragraph, rejection, as well as the Specification objection, have been overcome.

Claims 13–15, 19 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Brady (US 6,540,754), Claims 10 and 11 were rejected as being anticipated by Cumming '275 (US 6,503,275) and Claims 10, 11 and 19 were rejected as being anticipated by Cumming '708 (US 6,497,708). Claims 10, 11 and 21 were rejected under 35 U.S.C. § 102(a) as being anticipated by Blake (U.S. 5,468,246; newly cited). Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brady in view of Cumming '275.

Without acceding to the § 102 rejections, Claims 10, 13 and 19 have been amended to recite, more clearly, that the body has an inner arched surface and the sliding element slides the lens into the body and along the arched surface to roll or fold the lens. Support for this

amendment may be found, for example, in the Specification at Page 2 (3<sup>rd</sup> paragraph), Page 5 (1<sup>st</sup> paragraph), Page 6 (1<sup>st</sup>, 4<sup>th</sup> and 5<sup>th</sup> paragraphs), Page 6 (6<sup>th</sup> paragraph) to Page 7 (2<sup>nd</sup> paragraph), and Figures 1a,b,c, 2a,b,c, 3a,b,c; etc. Claim 20 have been amended to recite, more clearly, that the first wing has a plane resting surface that supports the lens, and Claim 22 has been added. Support for new Claim 22 may be found, for example, in the Specification at Page 7 (1<sup>st</sup> paragraph). No new matter has been added, and Applicant submits that none of the cited references, taken either singly or in combination, teaches or suggests all of the features recited by these claims.

**Claims 13, 19 and 20 Are Patentable Over Brady**

Brady discloses an intraocular lens (IOL) insertion system that includes a folding member 52 and a tubular body 54 with two curved walls 56a and 56b. *See, e.g., FIGS. 5A, 5B.* Wall 56b is fixed with respect to the tubular body 54, while wall 56a pivots about hinge 66 to form open and closed configurations. In the closed configuration, walls 56a, 56b define load chamber 70. Brady teaches that IOL 74 is positioned between open walls 56a, 56b and then folded into a U-shape when walls 56a, 56b are folded together.<sup>1</sup> Folding member 52 is then inserted into slot 84, contacts the mid-portion of singly-folded IOL 74 within load chamber 70 and folds IOL 74 (again) into an M-shape. Due to its "bi-stable resilient character," IOL 74 retains its multiply-folded shape after folding member 52 is removed from load chamber 70. *See, e.g., Col. 5:55 to Col. 6:61, Col. 7:8–17; FIGS. 4A, 4B, 5A, 5B, 8A, 8B.*

Brady fails to teach or suggest an approximately plane resting surface for supporting the lens in a partially folded or non-folded state, as recited by Claims 13 and 19. Instead, Brady discloses that two curved walls 56a, 56b support IOL 74. Applicant notes that, contrary to the Office Action's assertions, hinge 66 is a hinge and not "a planar resting surface 66." *See, Office Action on Page 3 (last paragraph).* Furthermore, Brady fails to teach or suggest a sliding element that slides the lens, supported on the planar resting surface, into the body and along the arched surface to fold or roll the lens, as recited by Claims 13 and 19. Rather, Brady discloses that IOL 74 is first folded into a U-shape when curved walls 56a, 56b are closed about hinge 66, and then folded into an M-shape when folding member 52 is advanced into load

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<sup>1</sup> FIG. 5A depicts a singly-folded, U-shaped IOL 74 positioned within load chamber 70. *See, also, FIG. 8A.*

chamber 70. Consequently, Brady fails to disclose all of the features recited by Claims 13 and 19.

Brady also fails to teach or suggest providing a first wing having an approximately plane resting surface that supports the lens in a partially folded or non-folded state, or folding the second wing onto the first wing so that the lens supported on the resting surface is held between the two wings, as recited by Claim 20. Brady’s external folding wings 72a, 72b neither support nor hold his IOL 74. To the contrary, Brady clearly teaches that the inner surfaces of curved walls 56a, 56b support and hold IOL 74, in both the singly-folded and multiply-folded configurations. Applicant notes that the Office Action admits as much.<sup>2</sup> Consequently, Brady fails to disclose all of the features recited by Claim 20.

#### **Claim 10 Is Patentable Over Cumming '275**

Cumming '275 discloses a lens insertion assembly 12 that includes a receptacle 22 and a tubular portion 24 that has a bore 30 and a tip 26 for inserting the lens into the patient’s eye. Cumming '275 teaches that ram 36 moves unfolded lens 16, from a stored position within lens storage space 34, into bore 30, and folds lens 16 into a compact, folded configuration. *See*, e.g., Col. 5:11–53, Col. 6:14–26; FIGS. 6, 7, 10 and 11.

Cumming '275 fails to teach or suggest a sliding element that slides the lens, supported on the planar resting surface, into the body and along the arched surface to fold or roll the lens, as recited by Claim 10. Instead, Cumming '275 clearly discloses that unfolded lens 16 is *already stored*, in an unfolded configuration, within receptacle 22. Consequently, Cumming '275 fails to disclose all of the features recited by Claim 10.

#### **Claims 10 and 19 Are Patentable Over Cumming '708**

Similarly, Cumming '708 discloses a lens insertion assembly 12 that includes a receptacle 18 and a tubular portion 20 that has a lumen 21 and a tip 24 for inserting the lens into the patient’s eye. Cumming '708 teaches that ram 32 moves unfolded lens 16 from a stored position, within lens storage chamber 26, into lumen 21 while folding lens 16 into a compact, folded configuration. *See*, e.g., Col. 1:38–65; FIGS. 1, 11A, 11B.

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<sup>2</sup> *See*, Office Action at Page 3 (last paragraph) (“If the IOL was of a size to not fill the entire arched surface then sliding movement of 80 would cause the IOL to slide along the arched surface to some degree during folding of the IOL.”)

Cumming '708 fails to teach or suggest a sliding element that slides the lens, supported on the planar resting surface, into the body and along the arched surface to fold or roll the lens, as recited by Claims 10 and 19. Instead, Cumming '708 discloses that unfolded lens 16 is *already stored* within receptacle 18. Consequently, Cumming '708 fails to disclose all of the features recited by Claims 10 and 19.

**Claim 10 Is Patentable Over Blake**

Blake discloses an intraocular lens injector 10 that includes an insertion portion 14 and a compression portion 12 with a shuttle member 16, an intraocular receiving channel 18 and a mating cylindrical passageway 20. Blake teaches that intraocular lens 65 is first placed within the intraocular lens receiving channel 18, the shuttle member 16 is then inserted into the intraocular lens receiving channel 18 and "gently manually" urged forward to push intraocular lens 65 into cylindrical passageway 20. As intraocular lens 65 advances into cylindrical passageway 20, it takes on a cylindrical shape. Col. 4:54–61, 7:28–47; FIGS. 1, 2, 6a, 6b.

Blake fails to teach or suggest a sliding element that slides the lens, supported on the planar resting surface, into the body and along the arched surface to fold or roll the lens, as recited by Claims 10 and 19. Instead, Blake discloses that shuttle member 16 is inserted within intraocular lens receiving channel 18 *after* intraocular lens 65 has been manually inserted. Consequently, Blake fails to disclose all of the features recited by Claim 10.

Accordingly, Claims 10, 13, 19 and 20 are allowable over the cited references. Claims 11 and 21, depending from Claim 10, and Claims 14–17 and 22, depending from Claim 13, are also allowable, at least for the reasons discussed above.

In view of the amendments and remarks presented herein, Applicant respectfully submits that this application is in condition for allowance and should now be passed to issue.

A Notice of Allowance is respectfully solicited.

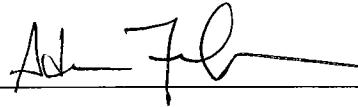
If any extension of time is required in connection with the filing of this paper and has not been requested separately, such extension is hereby requested.

The Commissioner is hereby authorized to charge any fees and to credit any overpayments that may be required by this paper under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,

April 2, 2007

By: \_\_\_\_\_

A handwritten signature in black ink, appearing to read 'Adam M. Treiber', written over a horizontal line.

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